

- 8 -

Serial No. 09/987,828

Commissioner for Patents

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

Claim Rejections -35 USC § 112

Claims 1 and 15 are rejected as indefinite. Applicant respectfully disagrees nonetheless, these rejections are traversed by amendment, as claim 1 has been cancelled, and claim 15 has been amended to remove the word "corresponding".

Applicant has cancelled claim 1 and amended claim 6 in independent form. Claims 2-5 and 7-14 are amended to remove the phrase "step of". Claims 2, 3 and 7 are also amended to correct dependencies. Typographical errors in claims 3 and 10 have also been identified and corrected.

Claim Rejections -35 USC § 102

The Office Action rejected claims 1-3 under 35 U.S.C. 102(e) as being anticipated by PCT Application WO 01/03409 to Novak.

Novak provides a method for tracking changes to a database stored in a SIM card of a mobile station, where a checksum is stored in a memory of both the SIM card and the mobile station.

It is established law that in order to anticipate a claim, each element of the claim must be taught or inherently provided by the reference. The Office Action cites page 2 lines 13-22, and page 4 lines 1-12 as disclosing the comparison of a calculated CDC with a stored CDC in order to determine if a record has changed. The first citation merely indicate that each record in the database on the SIM card is compared with a corresponding record on the copy of the database on the mobile station. The latter excerpt discloses comparing a saved checksum stored on the mobile station (change log) with another checksum computed on the SIM card.

The present invention, it will be noted, provides the stored CDC on the token so that an applet that executes on the token itself can detect whether a record has been changed. By a record being changed means that the record on the electronic token

- 9 -

Serial No. 09/987,828

Commissioner for Patents

was changed with respect to itself, and not that the record has changed with respect to a mirrored database, as the phrase seems to mean in the Novak reference. Indeed, even though Novak suggests storing the checksum on the SIM card (p7, line 1, and the abstract) the only comparisons taught are between the two checksums each stored in respect of the two respective copies of the database. Accordingly, Novak does not teach comparing a calculated CDC with a stored CDC but rather two CDCs stored in different places.

Applicant further finds no indication that Novak contemplates an algorithm for comparison that is performed by the SIM card. It appears that Novak's process is some hybrid process performed on both the mobile station and the SIM card, as the checksum is retrieved and updated at both the SIM card and the mobile station. Accordingly the SIM card cannot perform the determination without being docked to a predetermined mobile station. There is therefore no teaching of an algorithm that can be performed by an electronic token to determine whether a record stored on the electronic token has changed.

New independent claim 23 has been added. Claim 23 claims a method applied at an electronic token which is not taught by, nor is it inherent in the teachings of Novak which requires comparisons and updates to values stored in the SIM card and on the mobile station. Furthermore the calculated CDC in claim 23 is compared with a stored CDC that is stored in a memory of the electronic token, permitting the token to identify changed records without recourse to an extrinsic database or stored value, thereby solving a problem not addressed by Novak. Accordingly new claim 23 is not anticipated by Novak.

Claim 1 has been cancelled, and claims 2 and 3 now depend from claim 6 which recites that executing the algorithm involves setting one of a plurality of flags to permit differentiation of changes, which is not taught or suggested by Novak.

Claim Rejections -35 USC § 103

The Office Action has rejected claims 4-8 as obvious having regard to Novak in view of United States patent 5,649,089 to Kilner. Kilner does not teach communications between an electronic token and an electronic token reader to which the

- 10 -

Serial No. 09/987,828

Commissioner for Patents

electronic token is docked. Rather Kilner's system relates to network controllers and communications with wireless subscriber units. Applicant submits that this is not analogous art, and there is no reason why the statement of the evolution of PCs and cellular telephones on page 1 lines 19-20 of Novak should direct the person of skill in the art toward the teachings of Kilner.

The Applicant submits that Kilner does not teach setting one of a plurality of flags for each change to differentiate types of changes as claimed in claim 6. There is only one flag disclosed in Kilner, and it is only set to indicate that a response is pending. The same flag is set regardless of a type of change and accordingly, Applicant respectfully disagrees with the rejection. The unexplained use of the old checksum in updating the backup database is not equivalent to setting a flag that differentiates a type of change. There is no indication that the old checksum will be used to provide the same information. It will be noted that a flag is a few bits whereas the old CRC would be, for example 16 bits (Col. 3: 43-44). While availability of memory is not a problem in the disanalogous environment of the network controller taught by Kilner, in the instant invention where electronic tokens are used, the memory capacity is severely restricted.

In any case Kilner does not teach the comparison within an electronic token of a CDC with an SCDC stored on the token, and as such amended independent claims 6 and its dependencies are not obvious having regard to Novak in view of Kilner. The rejection is thereby traversed.

In view of the Office Action, claims 4-22 stand rejected as obvious having regard to Novak in view of British patent 2,373,139 to Sellers et al. Sellers et al. was not reduced to practice in the United States prior to the filing date of the instant application and therefore does not constitute prior art. The rejection of claims 4-22 is thereby traversed.

- 11 -

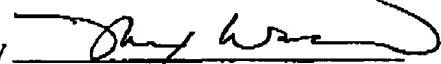
Commissioner for Patents

Serial No. 09/987,828

Conclusion

In view of the amendments made to the claims 2-15, the cancellation of claim 1 and the addition of claim 23 and for reasons set forth above, all claims in this application are now considered to be in a condition for immediate allowance. Favorable reconsideration and early issuance of a Notice of Allowance are therefore requested.

Respectfully submitted,
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